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10/014,637	10/26/2001	David C. Robinson	D/A0613Q	1407

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FAY SHARPE / XEROX - ROCHESTER
1100 SUPERIOR AVE.
SUITE 700
CLEVELAND, OH 44114

EXAMINER

ROHWER, JACOB P

ART UNIT PAPER NUMBER

2625

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/014,637	Applicant(s) ROBINSON ET AL.	
	Examiner Jacob P. Rohwer	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-18, 28-38 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-18, 28-38 and 40-49 is/are rejected.
- 7) ☒ Claim(s) 12-18 and 40-49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 October 2006 has been entered.

Claim Objections

Claims 12 – 18 and 40 - 49 are objected to because of the following informalities: Claims 12 - 18 have the exact same scope as claims 2 - 8 (because they are the exact same claims), similarly, claims 40 - 49 are the exact same as 29 - 38. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 recites the limitation "said memory" in Line 4. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5-8, 10, 15-18, 28, 32, 35-38 and 46-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 10-12, 14 and 22-24 of U.S. Patent Application No. 10/005582. Although the conflicting claims are not identical, they are not patentably distinct from each other.

With regard to similarities between the current application and application No. 10/005582, in claims 1, 5, 10-12, 14 and 22-24, a printing system and method are claimed in U.S. Patent Application No. 10/005582.

Claim 1 of current application:

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In claim 1 (10/005582) there is a document processing system having a document processing subsystem in which a job, **(Lin 1-2)** including a set of image data and a job control ticket, is processed each time the job, along with the job control ticket, is submitted to the document processing system, a job control system comprising: **(Lin 3-5)**

a master job control ticket for controlling a manner in which the job is processed in both a first job processing event and a second job processing event; **(Lin 11-15)** and

a first job control ticket with a first set of attributes, the first job control ticket controlling a manner in which the job is to be processed in the first job processing event, **(Lin 6-8)** and (b) program a second job control ticket with a second set of attributes, the second job control ticket controlling a manner in which the job is to be processed in the second job processing event; **(Lin 9-11)** and

a linking program, for linking the first and second job control tickets to the master job control ticket **(Lin 11-16)** wherein a single submission **(Lin 17)** of the job comprises a submission of the set of image data with the master job control ticket and causes the job to be processed as the first and second job processing events, **(Lin 18-21)** wherein the master job control ticket has user selectable global attributes and user selectable individual ticket attributes within the master job control ticket, the global attributes comprising properties affecting the tickets under the master job control ticket and the individual attributes comprising properties affecting only a selected ticket, and wherein the linking of the global and individual ticket attributes enables the processing of the first and second job processing events with the single submission of the job. **(Lin 11-15)**

With regard to differences between the current application and application No. 10/005582, in claim 1 of the current application an input source including a user interface with a display is specified. This limitation is not claimed in application No. 10/005582. However it would have been obvious to include this limitation in order to allow the users to provide selected attributes as specified in claim 1 of application No. 10/005582. **(Lin 11-12)** Furthermore, claim 1 of application No. 10/005582, while specifying a document processing system with at least one document processing subsystem, **(Lin 1-1)** is directed toward a method comprising a number of steps while claim 1 in the current application is directed toward components of a system. However, it would have been obvious to include a master job control ticket, an input source that allows the programming of the first and second job processing events, and a linking program as specified in claim 1 of the current application, in the application of 10/005582. The suggestion/motivation for doing so would have been to allow the method of claim 1 (10/005582, programming first and second job control tickets, and then linking them to a master job control ticket) to be realized by providing a system and corresponding components to carry out the steps.

Claim 5 of current application:

In claims 1 and 10 (10/005582) it claims:

a first set of one or more image processing operations **(Claim 1 specifies multiple renderings)** is performed on a copy of the set of image data in the first job processing event and a second set of one or more image processing operations is

performed on a copy of the set of image data in the second job processing event.

(Claim 10 Lin 1-5)

Claim 6 of current application:

In claims 1 and 11 (10/005582) it claims:

wherein a first set of make-ready operations is performed on a copy of the set of image data in the first job processing event and a second set of make-ready operations is performed on a copy of the set of images in the second job processing event. **(Claim 11 Lin 1-4)**

Claim 7 of current application:

In claims 1 and 5 (10/005582) it claims:

an editing operation is performed on at least one of the first and second job control tickets. **(Claim 5 Lin 1-2)**

Claim 8 of current application:

In claims 1 and 12 (10/005582) it claims:

the first and second job control tickets are configured so that the first set of attributes includes at least one attribute corresponding with a first type of offline finishing and/or the second set of attributes includes at least one attribute corresponding with a second type of offline finishing. **(Claim 12 Lin 1-5)**

Claim 10 of current application:

In claims 1 and 14 (10/005582) it claims:

the master job ticket includes first and second user selectable portions corresponding respectively with the first and second job control tickets, wherein the first

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user selectable portion is selected and the second user selectable portion is not selected, the job is processed in accordance with the first job processing event with the first job control ticket and not in the second job processing event in accordance with the second job control ticket. **(Claim 14 Lin 1-6)**

Regarding claims 15-18 of the current application, please see the rejections of claims 5-8 above, respectively.

Claim 28 of current application:

Please see rejection of claim 1 above. Additionally, claim 28 includes the limitation of a memory. **(Line 5)** However, this limitation is inherent in view of the fact claim 1 specifies a document processing system. **(Lin 1-2)** A memory is an integral and common component in a document processing system as specified in claim 1 of application No 10/005582.

Claim 32 of current application:

In claims 22-24 (10/005582) it claims a system corresponding to the method of claim 1:

wherein one of the first and second printers comprises a xerographic printer.

(Claim 24 Lin 1-2)

Regarding claims 35-38 and 46-49 of the current application, please see the rejections of claims 28 and 5-8 above, respectively.

Therefore, claims 1, 5-8, 10, 15-18, 28, 32, 35-38 and 46-49 of the current application are not patentably distinct from the claims mentioned above in U.S. Patent Application No. 10/005582.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-18, 28-38 and 40-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No 6,134,568 to Tonkin, in view of US Patent No 6,509,974 to Hansen, as cited in the previous rejections.

Regarding claim 1, Tonkin discloses a document processing system (**Fig 1**) having a document processing subsystem (**Fig 1 #71-73**) in which a job, including a set of image data (**Fig 5F #312**) and a job control ticket, (**Fig 5F**) is processed each time the job, along with the job control ticket, is submitted to the document processing system, (**Fig 4 #270**) a job control system comprising:

a master job control ticket for controlling a manner in which the job is processed in both a first job processing event and a second job processing event; (**Fig 5C-E allow a user to set attributes corresponding to a selected job component, and then add different components to the complete job for the overall job compositions as disclosed in Fig 5B #328. Fig 5B #314, #316-318, #320, #322 and #324 discloses attributes corresponding to the complete document assembly (master ticket) and Fig 5F discloses a summary where the global attributes (top of GUI) and the individual attributes (first and second processing events, #326) are linked**

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together in order to provide the document composition including the different renderings applied to the document components #431- #436) and

an input source including a user interface with a display, (Fig 1 #31-32 discloses terminal units in which data represented in the GUI disclosed in Fig 5A-E can be entered) the user interface being used to (a) program a first job control ticket with a first set of attributes, the first job control ticket controlling a manner in which the job is to be processed in the first job processing event, and (b) program a second job control ticket with a second set of attributes, the second job control ticket controlling a manner in which the job is to be processed in the second job processing event; (Fig 5C-E allow a user to set attributes corresponding to a selected job component, and then add different components to the complete job for the overall job compositions as disclosed in Fig 5B #328.) and

a linking program, for linking the first and second job control tickets to the master job control ticket (Fig 5F discloses the complete document composition wherein the different tickets as discussed above are linked together to form the complete document) wherein a single submission of the job (Fig 9 OK submits the complete job to the subsystem in one submission, Fig 4 #270) comprises a submission of the set of image data with the master job control ticket and causes the job to be processed as the first and second job processing events, wherein the master job control ticket has user selectable global attributes and user selectable individual ticket attributes within the master job control ticket, the global attributes comprising properties affecting the tickets under the master job control ticket and the individual attributes comprising properties

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affecting only a selected ticket, and wherein the linking of the global and individual ticket attributes enables the processing of the first and second job processing events with the single submission of the job. **(Fig 1 #71-73, Col 14 Lin 32-34)**

Although Tonkin discloses, document assembly and output techniques are well known in the art, he does not expressly disclose multiple printers providing different processing capabilities, corresponding to different job events, at the document processing locations. However, Hansen discloses a job ticket preparation system and method, wherein there are multiple printers to accommodate different job processing events at the document processing location. **(Fig 1b)**

The Tonkin and Hansen Patents are combinable because they both come from the same field of endeavor relating to producing a document at a processing station.

At the time of the invention it would have been obvious to one of ordinary skill in the art to process the document as specified in the Tonkin Patent at multiple printers as specified in the Hansen Patent.

The suggestion/motivation for doing so would have been provide the necessary functions for output of the document.

Therefore it would have been obvious to combine the Tonkin and Hansen Patents in order to obtain the invention as specified in claim 1.

Regarding claim 2, the combination further discloses in Hansen the job control system of claim 1, wherein the document processing subsystem includes first and second printers communicatively coupled with a network, and wherein a first copy of the image data is processed at the printer with the first job control ticket and a second copy

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of the image data is processed at the second printer with the second job control ticket.

(Fig 1b discloses multiple printers, Col 7 Lin 1-10)

Regarding claim 3, the combination further discloses in Hansen the job control system of claim 1, wherein the document processing subsystem includes an image capture device. **(A scanner is shown in Fig 1a, Fig 2, Fig 6 and discussed in Col 2 Lin 30, Col 4 line 41, Col 9 Lin 32 and 40)**

Regarding claim 4, the combination further discloses in Hansen the job control system of claim 3, wherein a file is generated from the image data set with said image capture device by reference to one of the first and second job control tickets **(a print job file with a ticket and print image data from the scanner is generated at the job preparation station 116 [Fig 1] by accepting image data from the scanner and preparing a print file by editing the image data and attaching a print ticket [thus referencing a job ticket in order to generate the print job file], and then the job file is stored in the library, Col 4 Lin 40-60 and Col 5 Lin 63-37), and where the file is transmitted across the network to memory (scanned in copies stored in the document library 118 for document management and job preparation, in the case of Fig 1a over the network from the station 116 to the library (mislabelled as 114); Col 5 Lin 63-67).**

Regarding claim 5, the combination further discloses in Tonkin the job control system of claim 1, wherein a first set of one or more image processing operations is performed on a copy of the set of image data in the first job processing event and a second set of one or more image processing operations is performed on a copy of the

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set of image data in the second job processing event. **(Fig 5F #431-436 discloses different processing operations to be applied to the different job events.)**

Regarding claim 6, the combination further discloses in Hansen the job control system of claim 1, wherein a first set of make-ready operations is performed on a copy of the set of image data in the first job processing event **(Col 5 Lin 15-32, Col 7 line 8, Col 19 Lin 54-57, wherein the entire print job [for example Book 2 of Fig 4], including master ticket and individual page tickets is made ready for whatever specific printing of each is needed into a printer ready format)** and a second set of make-ready operations is performed on a copy of the set of images in the second job processing event. **(The conversion to a printer ready format would inherently be different between two different pages with two different page tickets due to different image data and output settings, such as page 2 and 4 of Book 2, for example if one page was black and white the other color, the system would have different operations for preparing them for printing, especially in the case where the job is being prepared for printing across multiple printers as shown in Fig 7)**

Regarding claim 7, the combination further discloses in Tonkin the job control system of claim 1, wherein an editing operation is performed on at least one of the first and second job control tickets. **(Fig 5F #332 allows a user to edit the processing operations on one of the tickets #431-436)**

Regarding claim 8, the combination further discloses in Tonkin the job control system of claim 1, wherein the first and second job control tickets are configured so that the first set of attributes includes at least one attribute corresponding with a first type of

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offline finishing and/or the second set of attributes includes at least one attribute corresponding with a second type of offline finishing. **(Fig 5F discloses binding and stapling, examples of offline finishing. As applied to claim 8, the first and second job control tickets include the master attributes as specified in claim 1 (binding and stapling), so the offline attributes set read on claim 12 as submitted since the word "or" is included, meaning the first or second job processing event includes this attribute, as disclosed. There is nothing in the claim language of claims 1 or 8 that distinguish that the offline attribute is an individual and not a global attribute that is applied to either the first or second event.)**

Regarding claim 10, the combination further discloses in Tonkin the job control system of claim 1, wherein the master job ticket includes first and second user selectable portions corresponding respectively with the first and second job control tickets, wherein the first user selectable portion is selected and the second user selectable portion is not selected, the job is processed in accordance with the first job processing event with the first job control ticket and not in the second job processing event in accordance with the second job control ticket. **(Fig 5F #330 discloses a button to remove one of the document components or job processing events and its corresponding attributes selected by the user, disclosing that the second processing event can be removed, and not selected if desired by the user, while the first job processing event is rendered at the printer accordingly.)**

Regarding claim 11, the combination further discloses in Tonkin the job control system of claim 1, wherein the master job control ticket includes a third user selectable

portion corresponded with a global instruction so that when the first, second and third user selectable portions are selected, the global instruction is used to process the job in each of the first job processing event and the second job processing event. **(Fig 5F #316--#318, #320, #322, #324 are all third user selectable portions corresponded with an instruction used to process all the job processing events in #431--#436)**

Regarding claims 12-18, please see claim objections above and the rejections of claims 2-8.

Regarding claim 28, please see rejection of claim 1. Additionally the combination specified in claim 1 discloses client computer workstations, **(Tonkin Fig 1 #31-32 and Hansen Fig 1a "Client PC")** and it is well known in the art that these workstations comprise a **memory** for storing documents for files to be printed. The remainders of the elements in claim 28 were addressed in the rejection of claim 1.

Regarding claim 29, the combination further discloses in Hansen, the document processing system of claim 28, wherein the data structure is embedded in the page description language of a file or a document. **(Col 4 Lin 23-38 discloses how the workstations at the photo shop are configured to receive documents or files, over a network, i.e. from a client PC as disclosed in Fig 1a, in a printer ready format, such as PDL shown in Fig 2)**

Regarding claim 30, the combination further discloses in Hansen, the document processing system of claim 28, in which the document processing subsystem communicates with said memory by way of a network, wherein the document

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processing subsystem is separated from said memory by the network. **(Tonkin Fig 1 #50 and #70 and Hansen Col 4 Lin 26-29)**

Regarding claims 31 and 33-38, please see rejection of claims 2 and 3-8 respectively above.

Regarding claim 32, the combination further discloses in Hansen, the document processing system of claim 31, wherein one of the first and second printers comprises a xerographic printer. **(Digimaster 9110 of output devices 122 is at least one example, Fig 1b and Fig 2; Col 7 Lin 50-56)**

Regarding claims 40-49, please see claim objections above and the rejections of claims 29-38.

Response to Arguments

Applicant's arguments with respect to claims 1-8, 10-18, 28-38 and 40-49 have been considered but are moot in view of the new ground(s) of rejection.

Furthermore, applicant's arguments with regard to the fact that the previous grounds of rejection using Hansen does not provide multiple alternative renderings to the same image job data have been fully considered but they are not persuasive. The arguments are not persuasive due to the fact that nowhere in the independent (or dependent) claims, is the language limited to multiple alternative renderings of the *same* job data (or image data), or first and second alternative job processing events applied to the *same* job data. As a result, the Tonkin Reference has been provided to disclose that multiple renderings of a document can occur in one submission, and this reference (in combination with Hansen) reads on the claims as submitted due to the fact that the

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claim language does not distinguish that the "multiple distinct renderings" are applied to the *same* set of image data as argued by applicant.

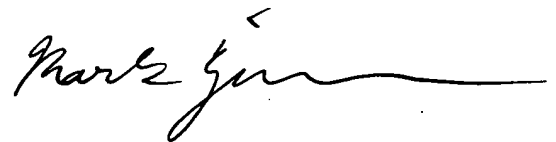
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob P. Rohwer whose telephone number is 571-272-5509. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK
11/13/06



MARK ZIMMERMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600